

## **REMARKS**

### **35 U.S.C. §101 rejections**

In the March 5, 2009 Office Action claims 25 – 32 and 49 - 62 are rejected under 35 U.S.C. §101 as representing non statutory subject matter. The Assignee traverses the rejections for non statutory subject matter in a number of ways. First, by noting that the Office Action has failed to establish a prima facie case of non statutory subject matter. Second, by noting that the claim rejections are not in compliance with the Administrative Procedures Act and are therefore moot. Third, by noting that the claims rejections are non statutory. Fourth, by noting that the claimed inventions describe inventions that transform data representative of an organization that physically exists into a different state or thing and thus represent statutory subject matter.

In particular, the March 5, 2009 Office Action fails to establish a prima facie case of non statutory subject matter for claim 25 – 32 and 49 - 62 in a number of ways. It is well established that the burden is on the USPTO to set forth a prima facie case of unpatentability In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). In spite of this well known requirement, the March 5, 2009 Office Action contained only conclusory statements that the rejected claims represented non-statutory subject matter. In short, the complete absence of evidence leads to the inevitable conclusion that the Examiner has failed to establish a prima facie case that would support a §101 rejection for a single claim.

### **35 U.S.C. §112 first paragraph rejections**

In the March 5, 2009 Office Action claim 62 is rejected under 35 U.S.C. §112 second paragraph. In particular, the Examiner feels that the term “intelligent agent” has not been adequately explained. The Assignee traverses the rejection by noting that is well known to those of average skill in the art that the term intelligent agent is used interchangeably with the term bot. Furthermore, the definition of bot used in the specification corresponds to a widely accepted definition of the term “intelligent agent”.

### **35 U.S.C. § 112 Second Paragraph Rejection of Claims**

In the March 5, 2009 Office Action claims 25 – 32 and 49 - 62 are rejected under 35 U.S.C. §112 second paragraph. In particular, the Examiner feels that the meaning of several terms are unclear. The Assignee respectfully traverses the rejections for indefiniteness in three ways. First, by noting that the instant Office Action fails to establish a prima facie case of

indefiniteness. Second, by noting that the assertions regarding the alleged indefiniteness of the claims are not in compliance with the requirements of the Administrative Procedures Act and are therefore moot. Third, by noting that the claim rejections are non-statutory. The Assignee also notes that claim amendments have obviated many if not all of the claim rejections.

As discussed previously, the March 5, 2009 Office Action fails to establish the prima facie case of indefiniteness required to sustain the rejections of claims 25 – 32 and 49 - 62. *MPEP 2173.02 states that: definiteness of claim language must be analyzed, not in a vacuum, but in light of: (A) The content of the particular application disclosure; (B) The teachings of the prior art; and (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. In reviewing a claim for compliance with 35 U.S.C. 112, second paragraph, the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph, by providing clear warning to others as to what constitutes infringement of the patent. See, e.g., Solomon v. Kimberly-Clark Corp., 216 F.3d 1372, 1379, 55 USPQ2d 1279, 1283 (Fed. Cir. 2000). See also In re Larsen, No. 01-1092 (Fed. Cir. May 9, 2001).* In the case of claims 25 – 32 and 49 - 62 the Examiner has failed to establish the prima facie case that the specification does not meet the requirements of §112 second paragraph in five ways for every rejected claim. The five ways are: by failing to interpret the claims in light of the specification, by failing to provide any evidence that someone of average skill in the relevant arts would have difficulty interpreting the claims (there are no declarations from anyone of average skill in the art), by failing to establish that the limitation(s) in the claims fail to describe the invention, by failing to consider the teachings of the prior art and/or by failing to consider the claim as a whole. In particular, the Assignee traverses the rejections by noting that the rejected claims do not contain any terms that do not have proper antecedent basis where such basis is not otherwise present by implication or the meaning is not reasonably ascertainable (*Halliburton Energy Services, Inc. v. M-I LLC*, 514 F.3d 1244, 1255, 85 USPQ2d 1663 (Fed. Cir. 2008) and *Halliburton*, 514 F.3d at 1246, 85 USPQ2d at 1658 (Citing *Biomedino, LLC v. Waters Techs. Corp.*, 490 F.3d 946, 950 (Fed. Cir. 2007)).

### **Request for Correction**

In accordance with the relevant statutes and precedents the Assignee is entitled to expect and receive: an unbiased patent application examination conducted by an Examiner with knowledge of the relevant arts who follows the law. To date, the activity associated with the instant patent

application bears no resemblance to the patent application examination standards dictated by statute and precedent. Prompt correction is requested.

#### **Statement under 37 CFR 1.111**

37 CFR 1.111 requires that the basis for amendments to the claims be pointed out after consideration of the references cited or the objections made. 37 CFR 1.111 states in part that:

*In amending in response to a rejection of claims in an application or patent undergoing reexamination, the applicant or patent owner must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. He or she must also show how the amendments avoid such references or objections.*

The Assignee notes that this requirement is not relevant to the instant application because, as detailed above, there are no references or objections to avoid. Having said that, the Assignee notes that the primary reason the prior set of claims were amended was to correct clerical errors and put the application in final form for issue and allowance.

#### **Reservation of rights**

The Assignee hereby explicitly reserves the right to present the previously modified and/or canceled claims for re-examination in their original format. The cancellation or modification of pending claims to put the instant application in a final form for allowance and issue is not to be construed as a surrender of subject matters covered by the original claims before their cancellation or modification.

#### **Conclusion**

The pending claims are of a form and scope for allowance. Prompt notification thereof is respectfully requested.

Respectfully submitted,  
Asset Trust, Inc.

/B.J. Bennett/

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